

REMARKS

Claims 1-28 were presented for examination in the present application. The instant amendment cancels non-elected claims 20-27 without prejudice. Thus, claims 1-19 and 28 are presented for consideration upon entry of the instant amendment. Claim 1 is independent.

Applicant respectfully reserves the right to file a divisional application directed to the non-elected subject matter.

Claim 7 has been amended to better conform to the elements of independent claim 1. This amendment merely makes explicit what had been implicit in the claim.

Claim 3 was rejected under 35 U.S.C. §112, second paragraph.

Claim 3 has been amended to correct an ambiguity resulting from translation into the English language. Applicant submits that this amendment merely makes explicit what had been implicit in the claim and is believed to obviate the rejection to claim 3. Accordingly, reconsideration and withdrawal of the rejection to claim 3 are respectfully requested.

Independent claim 1 was rejected under 35 U.S.C. §102(b) or in the alternative under 35 U.S.C. §103(a) over German Patent No. DE3624164 to Haacke (Haacke). Dependent claims 2-19 and 284 were rejected variously under 35 U.S.C. §103(a) over Haacke in view of one or more of German Patent No. DE4218365 to Guchert et al. (Guchert), U.S. Patent No. 2,074,339 to Miles (Miles), U.S. Patent No. 6,031,012 to Nakanishi et al. (Nakanishi), U.S. Patent No. 1,726,078 to Leyst (Leyst), U.S. Patent No. 4,133,932 to Peck (Peck), U.S. Patent No. 3,754,930 to Toei et al. (Toei), U.S. Patent No. 1,970,426 to Levin (Levin), U.S. Patent No. 3,672,385 to Matzen (Matzen), U.S. Patent No. 3,959,191 to Kehr et al. (Kehr), and the article to Wells (Wells).

Applicant respectfully traverses this rejection.

The present application, as well as the Haacke reference both were originally filed in the German language. The Office Action is now comparing English translations of these documents, which masks the differences in their content. More specifically, Applicant submits that the translation provided by the Office Action mis-characterizes the disclosure of Haacke.

Independent claim 1 recites, in part, natural straw that "is at least partly **disintegrated**" (emphasis added).

The "disintegrated" element of claim 1, as originally filed in the German language, was written as "aufgeschlossen", which is a technical term of art that is more precise a term than the English "disintegrated". None-the-less, the present application closes this gap with respect to the "disintegrated" term by disclosing that:

"By the disintegration in a favourable way the natural structur of the straw in the form of fibres bound to stalks, thus its stalky and stiffend structure, is at least partly lost.

By the disintegration of the straw it happens that, in other words, the straw fibres which make up the stalks together with natural binding substances are **extracted from** this natural structure of the straw stalks.

The stalk structure, which is created by a natural pentosan -, lignin – and/or cellulose binding of the straw fibres to straw stalks, is in the process of disintegration **unfastened in a way that the natural structur of the straw in its original form of straw stalks, build of fibres, is at least partly broken up.**" See page 5, line 21 through page 6, line 11.

Thus, the present application makes clear, even though the English translation of the "aufgeschlossen" becomes somewhat less precise than the term of art in the original German language, what is meant by the "disintegration" element, namely that the stalk structure or binding substances (i.e, the pentosan, lignin, and/or cellulose binding) are **extracted from** the straw fibers.

In contrast, the Office Action asserts that Haacke discloses the use of decomposed straw in deadening materials. Applicant respectfully submits that this assertion is a clear mischaracterization of the teachings of Haacke.

More specifically, Applicant submits that Haacke fails to disclose or suggest the use of decomposed straw in its deadening material. Rather, Haacke merely teaches that some waste materials (which are traditionally allowed to decompose or are incinerated) could, **instead** of being placed into the waste stream (decomposed or incinerated), be used in deadening materials.

The translation provided by the Office Action itself proves this point by disclosing that:

"The invention is based on the realization that there are a multitude of waste products with suitable attenuation data, for example, low heat conductivity, whose original use served other purposes than the attenuation and which represent a burden as waste on the environment. These materials are, for example, valuable materials such as plastic (cups, bags, or the like), rubber (tires and the like), and waste paper or recycling raw materials, such as straw and wood. The waste materials could be allowed to decompose or could be incinerated. Attempts at allowing the waste materials to decompose have not led in many cases to the expected results. Styrofoam, pantyhose, and polyethylene bags appear to be almost everlasting. It is known to incinerate many of these materials in special incinerators. However, some materials develop noxious gases during incineration. It is also known to utilize a few materials for other purposes, such as shock absorbers (fenders) from old rubber tires and waste paper as toilet paper. Glass as frequently occurring waste product is almost impossible to recycle for other purposes and is only recyclable through melting.

It is an object of the invention to create a new recycling process for many recycling materials, especially non-decomposable materials." See page 5, line 18 through page 6, line 13.

As seen above, Applicant submits that Haacke merely discloses some materials are "waste materials" that have properties (e.g., heat attenuation) that can be used in other products. In doing so, these "waste materials" can be removed from the normal processes that are typically used to dispose of the material (e.g., decomposition,

incineration, re-melting, etc.). However, Haacke simply never discloses or suggests that the decomposed waste itself is used in the deadening material. Further, Haacke never discloses or suggests that the desired attenuation property remains after decomposition has occurred such that it could be used in a deadening material.

Further, Applicant submits that even if one were to presume *arguendo* that Haacke combines decomposed waste with a binder to form an attenuation material (which it does not), Applicant maintains that "decomposition" as disclosed by Haacke is not "disintegration" as claimed for the reasons discussed above.

Moreover, Applicant notes that original claim 1 was indicated as patentable over Haacke during the PCT Proceedings in the European Patent Office, where these proceedings were undertaken in the German language and, thus, avoided the aforementioned ambiguities in translation. See claim 1 of corresponding European Patent No. EP 1 572 500.

The Office Action fails to assert that any of the remaining references, namely Guchert, Miles, Nakanishi, Leyst, Peck, Toei, Levin, Matzen, Kehr, and Wells, cure the aforementioned deficiencies present in the disclosure of Haacke.

Accordingly, Applicant submits that the Office Action has failed to establish a *prima facie* case of anticipation or obviousness of claim 1 over the cited art. Applicant therefore submits that claim 1, as well as claims 2-19 and 28 that depend therefrom are allowable over the cited art. Reconsideration and withdrawal of the rejection to claims 1-19 and 28 are respectfully requested.

In view of the above, it is respectfully submitted that the present application is in condition for allowance. Such action is solicited.

If for any reason the Examiner feels that consultation with Applicant's attorney would be helpful in the advancement of the prosecution, the Examiner is invited to call the telephone number below.

Respectfully submitted,

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